

Attorney Docket No. 8160

Serial No. 09/902,321

Claims 3, 9, 11, and 14 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. First, the Office asserted that Claim 3 contained an improper Markush group. Accordingly, Applicants have amended Claim 3 to put the Markush group contained therein in proper form. Secondly, Claim 9 included typographical errors, parenthetical language, and an extra "and". Applicants have amended Claim 9 to correct the typographical errors, remove parenthetical language, remove the extra "and", and insert commas where appropriate. Thirdly, Claim 11 was deemed indefinite because of the phrase "hydantoin derivatives" because the Office believes that it is unclear what "derivatives" means. Applicants assert that a skilled artisan would easily recognize the meaning of the term "derivatives" in such a context but in order to expedite prosecution Applicants have removed the term from the claim. Finally, Claim 14 failed to state the basis of the amount of air present in the claimed composition. Applicants have amended the claim to recite that each of the amounts claimed therein are based on the weight of the composition. Therefore, each of the bases for this rejection under §112, second paragraph has been addressed. Applicants submit that the rejection is improper in view of the aforementioned amendments and therefore request reconsideration and withdrawal of the rejection.

#### REJECTIONS UNDER 35 USC §103(a)

Claims 1-10 and 12-14 have been rejected under 35 USC §103(a) as being unpatentable over Tachibana et al. (USP 5412004). The Office asserts that the limitations currently claimed by Applicants are all taught with the exception of the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer, and the amount of air contained in the composition. Furthermore, the Office reasons that it is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. Therefore it would have been within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes. Applicants traverse this rejection.

Applicants respectfully submit that the present invention would not have been obvious over Tachibana. First of all, Tachibana discloses a silicone polymer, a paste-like composition prepared by kneading the silicone polymer and a silicone oil under a shearing force, and a water-in-oil type cosmetic composition comprising the paste-like silicone composition as an oil phase component. In particular, Tachibana discloses a silicone polymer that is prepared by the addition polymerization of components comprising an  $R^1_aR^2_bH_cSiO_{(4-a-b-c)/2}$  (1) or  $R^1H_3SiO_{(4-a)/2}$  and a polyoxyalkylene  $C_mH_{2m-1}O(C_2H_4O)_n(C_3H_5O)_jC_mH_{2m-1}$  or an organopolysiloxane  $R^1R^2SiO_{(4-a)/2}$  (B), including (1) or (A) as an essential component. The reference, however, fails to teach or suggest a composition as Applicants currently claim that includes solid particle-containing discontinuous phase that has a droplet size distribution range of from about 0.1 microns to about 100 microns or the claimed average particle size for such particles. Moreover, the reference fails to teach or suggest that such particles are uniformly distributed on the skin independent of skin topography once the composition is applied to skin as in the present invention. Applicants have surprisingly found that compositions as claimed that exhibit this characteristic also tend to exhibit minimized agglomeration of the solid particles and thus yield improved deposition of the overall composition onto the skin. Without being limited by theory, these solid particles are delivered to the skin by means of emulsion droplets having the claimed droplet size distribution. Applicants have found that the solid particles are dispersed within and/or at the droplet interface of the emulsion system such that capillary-induced agglomeration of the particles is confined within the space or volume occupied by the droplet, thereby providing a more even distribution of the broad range of particles on skin. Additionally, the droplets serve as a barrier preventing agglomeration as a result of application shear. These principles/observations are not disclosed expressly or implicitly in the Tachibana reference. Additionally, Applicants find no

Attorney Docket No. 8160

Serial No. 09/902,321

teaching or suggestion in the reference of aerating the compositions disclosed therein. Thus, it would not have been obvious to a skilled artisan to modify Tachibana to arrive at the compositions of the present invention.

Claim 11 is rejected under 35 USC §103(a) as being unpatentable over Tachibana as applied to claims 1-10 and 12-14 and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., Van Nostrand Reinhold Co., New York (1981), pages 121, 385, 434, and 686 (hereafter "Hawley"). The Office believes that Hawley teaches the preservatives that are lacking in Tachibana's disclosure. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives disclosed in Hawley to the composition of Tachibana for their known antimicrobial effects. Applicants traverse this rejection.

As explained above relative to Tachibana, the reference fails to disclose the requisite limitations of Applicants' invention that deal with droplet size distribution. Therefore, the mere addition of Hawley's disclosure of commonly used preservatives fails to remedy this shortcoming. Thus, Applicants respectfully assert that this reference's disclosure of well known preservatives when viewed in combination with Tachibana would not have rendered Applicants' invention obvious since none of the benefits of the claimed composition are taught, suggested, or even recognized by either reference.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grablak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Thus, Applicants assert that a rejection under 35 USC §103(a) as unpatentable over the cited references is improper and therefore request withdrawal of the rejection and reconsideration.

#### DOUBLE PATENTING

Claims 1-14 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-17 of copending Application No. 09/850,845 and Claims 1-13 rejected over Claims 1-21 of copending Application No. 09/850,763. The Office asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because each application is claiming compositions comprising a crosslinked siloxane elastomer and a solvent.

To simplify the issues in the present application, Applicants concurrently submit with this amendment the appropriate Terminal Disclaimer over the copending applications. In submitting this Terminal Disclaimer, Applicants state for the record that this Terminal Disclaimer is not an admission of obviousness. In fact, the Federal Circuit has held that:

[T]he filing of a terminal disclaimer "simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection."

Quad Envtl. Techs. Corp. v. Union San. Dist., 20 USPQ2d 1392 (Fed. Cir. 1991).

Applicants therefore submit that the obviousness-type double patenting rejection has been overcome.

Attorney Docket No. 8160

Serial No. 09/902,321

**CONCLUSION**

Based on the foregoing statements, Applicants respectfully submit that the Office has not made prima facie cases of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully submitted,

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Attorney Docket No. 8160

Serial No. 09/902,321

**MARKED VERSION SHOWING CHANGES MADE****IN THE SPECIFICATION**

Please substitute the current title with "Emulsion Cosmetic Compositions Comprising an Emulsifying Crosslinked Siloxane Elastomer".

Please substitute the second full paragraph of page 6 of the specification with the following paragraph:

" The organopolysiloxanes of the invention are obtained, in particular, according to the protocol of Examples 3, 4, and of the document EP-A545002 (or US-5,421,004) and from the examples of the document US-A-5,811,487."

**IN THE CLAIMS**

Please amend the claims as follows.

3. (Amended) The cosmetic composition of Claim 1 wherein said discontinuous phase is selected from the group consisting of polyhydric alcohol, water [or] and mixtures thereof.
9. (Amended) The cosmetic composition of Claim 8 wherein said solid particle is selected from the group consisting of gums, chalk, Fuller's earth, talc, kaolin, iron oxide, mica, sericite, muscovite, phlogopite, synthetic mica, lepidolite, biotite, lithia mica, vermiculite, magnesium carbonate, calcium carbonate, aluminum silicate, starch, smectite clays, alkyl and/or trialkyl aryl ammonium smectites, chemically modified magnesium aluminum silicate, organically modified montmorillonite clay, hydrated aluminum silicate, fumed silica, aluminum starch, octenyl succinate barium silicate, calcium silicate, magnesium silicate, strontium silicate, metal tungstate, magnesium, silica alumina, zeolite, barium sulfate, calcined calcium sulfate [(calcined gypsum)], calcium phosphate, fluorine apatite, hydroxyapatite, ceramic powder, metallic soap, colloidal silicone dioxide, boron nitride; polyamide resin powder, cyclodextrin, polyethylene powder, methyl polymethacrylate powder, polystyrene powder, copolymer powder of styrene and acrylic acid, benzoguanamine resin powder, poly(ethylene tetrafluoride) powder, [and] carboxyvinyl polymer, cellulose powder, ethylene glycol monostearate[,] , titanium dioxide, zinc oxide, magnesium oxide, interference pigments, and mixtures thereof.
10. (Amended) The cosmetic composition of Claim 10 wherein said preservative is selected from the group consisting of disodium EDTA, phenoxyethanol, methyl paraben, propyl paraben, imidazolidinyl urea, sodium dehydroacetate, para-hydroxybenzoic acid, hydantoin [derivatives], propionate salts, quaternary ammonium compounds, benzyl alcohol, and mixtures thereof.
14. (Amended) A cosmetic composition comprising:
  - (i) from about 0.1% to about 15%, by weight of the composition, of emulsifying crosslinked siloxane elastomer having an average particle size less than 20 microns;
  - (ii) from 10 to 80%, by weight of the composition, of a solvent for the crosslinked siloxane elastomer;
  - (iii) optionally, from 0 to 50%, by weight of the composition, of skin conditioning agent; and
  - (v) optionally, from above about 0 to about 95%, by weight of the composition, of waterwherein the composition contains at least about 1% air.